

B 47. The system according to claim 45 and wherein the lock further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.

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### **Remarks**

Claim 25 has been amended herein. New claims 45-47 have been added. Claims 1-47 are now pending in the Application.

### **Claims Withdrawn From Consideration With Traverse**

In the Action claims 4-23 and 27-44 were withdrawn from consideration despite Applicants' traverse. Applicants again respectfully object to the restriction requirement and request that it be withdrawn in view of the showings made herein that the base claims from which many of the claims withdrawn from consideration depend are patentably distinguishable over the cited art.

### **The Pending Claims Are Sufficiently Definite**

In the Action claims 25-26 were rejected pursuant to 35 U.S.C. § 112 second paragraph as not sufficiently definite. This rejection is respectfully traversed.

In the Action the last two lines of claim 25 were asserted to be indefinite because of the use of the conjunctive word "or" to refer to two situations, the earlier of which causes a further signal to be output. It is respectfully submitted that claim 25 was sufficiently clear to satisfy the statutory mandate as originally written. Applicants have however made the changes suggested by the Examiner as doing so does not in any way narrow the scope of the claim. It is respectfully submitted that these claims obviate any possible objection.

### **The Art Cited in the Action is Not Prior Art Against Applicants**

In the Action the claims were rejected pursuant to either 35 U.S.C. § 102 or 35 U.S.C. § 103 on the basis of Lavigne, et al. ("Lavigne") or Colson, Jr., et al. ("Colson"). Neither of these patents constitutes prior art against Applicants' claims.

This Application is entitled to the benefit under 35 U.S.C. § 120 of copending Application 08/361,783 which was filed December 16, 1994, as well as other copending applications. As documented in the enclosed Declaration of R. Michael McGrady submitted pursuant to 37 C.F.R. § 1.131, the subject matter of at least claims 24 and 45 was reduced to practice in this country prior to the filing dates of each of Lavigne and Colson. Indeed even the filing date of the parent application is earlier than Lavigne, and Colson's filing date is less than four months prior to the filing date of the pending application. These references may be sworn behind, thus obviating their effect as a reference against these claims.

The attached Declaration and documentation establish that the Applicant McGrady reduced to practice the invention recited in claims 24 and 45 in this country prior to the filing date of each of these references, or alternatively reduced to practice a system which renders the

subject matter of claims 24 and 45 obvious based on the system actually reduced to practice. For these reasons it is respectfully submitted that the objections against claim 24 and any claims that depend therefrom as well as any objection against claim 45 (which is a new claim comparable in scope to claim 24) that may be based on either of these references or a combination thereof, should be withdrawn.

As neither Lavigne nor Colson constitute “prior art” against Applicants, it is respectfully submitted that all the pending claims should be allowed.

### **The Cited Art Does Not Anticipate Applicants’ Claims**

In the Action claims 1, 3 and 24-25 were rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Lavigne. This rejection is respectfully traversed both on the basis that Lavigne is not prior art as discussed above, and for the reasons that follow.

In the Action Lavigne is asserted to include a computer in operative connection with a data store which includes user data representative of a plurality of authorized users. Lavigne is also asserted to disclose an interface which includes an input device. Lavigne is further asserted to disclose a refrigerator with a door, and an interior area with a storage location for at least one medical item. Lavigne is further asserted to disclose a lock module operatively attached to the refrigerator and operative responsive to the computer. Lavigne is further asserted to disclose that an input to the input device corresponding to data for an authorized user in the data store enables a user to input information corresponding to a medical item, and that the computer operates to output a signal which changes the lock to unlock the module. It is respectfully asserted that this interpretation of Lavigne is incorrect and the rejection is traversed.

### **The Lavigne Reference**

Lavigne discloses a carrier for holding and transporting medical items. It is designed to be carried by a medical technician or other person and to allow them to track their activity in removing medical items from the carrier. The enclosure of Lavigne includes an opening (49) with a hinged door (21) which can be moved to cover or uncover the opening (Column 4, line 65-Column 5, line 2). Within the enclosure is a drawer (41). The drawer is used to hold controlled substances. To open the drawer the operator must insert a key into a key lock (42) (Column 4, lines 41-45).

A carrier includes a controller (79) which monitors the temperature of drugs inside the carrier to be sure that temperature sensitive drugs therein are maintained within their proper temperature range. The controller also operates to record temperature conditions, as well as information concerning the identity of the person having custody of the carrier and events such as the opening of the door to access the medications in the carrier (Column 7, lines 53-Column 8, line 3; Column 9, lines 6-16). In this way activities by the person in possession of the carrier as well as temperature events are recorded over a period of time.

In operation of the device of Lavigne, when an operator takes control of the carrier the operator inserts a data key into a reader (73). This data is stored to indicate the person who has possession of the carrier (Column 14, lines 20-27). When the person in control of the carrier wishes to administer a drug, they can open the door (21), remove the desired drug from the carrier and administer the drug to the patient. The operator also records the administration of the drug by entering a code into memory (Column 14, lines 34-43).

The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Column 11, lines 37-43). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. However a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Column 12, line 64-Column 13, line 2).

Thus Applicants respectfully wish to point out that in the operation of Lavigne the door (21) which controls access to the medical items in the carrier is always open and accessible except when the door is locked due to the occurrence of an out of temperature condition.

### **Description of Claimed Invention**

The pending application claims a system for providing medical items. Claim 1 recites the features of a computer which is in operative connection with a data store. The data store includes user data representative of a plurality of authorized users. The data store also includes item data representative of a plurality of medical items, and location data representative of storage locations in which medical items are stored. Claim 1 also recites a user interface in operative connection with the computer, which user interface includes an input device. Claim 1 further recites a refrigerator with a door which controls access to an interior area of the refrigerator. The interior area includes a storage location for at least one medical item. Claim 1 further recites a lock module attached to the refrigerator which is in connection with the computer and which

operates in response to at least one signal from the computer to change the condition of the lock from the locked to the unlocked condition. Claim 1 further recites the relationship that in response to a user inputting identification data through the input device, which identification data corresponds to that of an authorized user in the data store, the computer enables the user to input indicia corresponding to a medical item through the input device. Claim 1 further recites that the computer is operative responsive to the input of the indicia corresponding to the medical item to provide a signal changing the lock module to an unlocked condition. This enables the door to be opened and the medical item in the storage location in the refrigerator to be accessed.

### **The Legal Standard**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all of the elements of a claimed invention arranged in a manner recited in the claim. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 148, 220 USPQ 193, 198 (Fed. Cir. 1983). Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure each and every element of the claimed invention recited in a manner such that the reference would literally infringe the claim if made later in time. Lewmar Marine, Inc. v. Barient, Inc., 822 F.2d 744, 747, 3 USPQ 2d 1766, 1768 (Fed. Cir. 1987).

### **Claim 1**

Claim 1 is not anticipated by Lavigne as the claim recites numerous features and relationships that are not disclosed or suggested by Lavigne. Specifically nothing in Lavigne compares identification information input by a user to data stored in a data store. As previously

discussed in the disclosure of Lavigne, the memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of authorized users.

Claim 1 further specifically recites that responsive to the input of identification data corresponding to an authorized user, a user is enabled to input data corresponding to a medical item. Again nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database.

Additionally claim 1 specifically recites that responsive to the input of the medical item indicia (which activity is enabled when the identification data input corresponds to an authorized user), the computer is caused to output a signal, which signal changes the lock module controlling the door of the refrigerator to an unlocked condition. Nothing in Lavigne discloses or suggests controlling a lock to open the door (21) in response to either medical item indicia or identification data corresponding to an authorized user. As Lavigne makes amply clear, the door (21) of his medication carrier is always unlocked except in circumstances when an out of range temperature condition has been sensed, in which case the door will lock because a temperature violation which could have damaged the medications has occurred (see Column 11, lines 37-43).

It is respectfully submitted that claim 1 recites numerous features and relationships which are neither disclosed nor suggested in Lavigne. For these reasons it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including any claims that are currently withdrawn from consideration) should be allowed.

### **Claim 3**

In the Action claim 3 was also rejected pursuant to 35 U.S.C. § 102(b) on the basis of Lavigne. The Action asserts that Lavigne discloses that a door is operative to generate an open signal responsive to the door opening, and that a computer is operative responsive to the open signal to change the lock module to a locked condition. This assertion is respectfully traversed.

Claim 3 depends from claim 1 and specifically recites a door sensor which is operative to sense opening of the door of the refrigerator, when the door opened in the manner discussed in connection with claim 1. Claim 3 further recites that the computer operates responsive to the open signal from the sensor to change the lock module to a locked condition, so that the door will be held closed when the door is next returned to a closed condition.

As previously discussed the Lavigne system senses the opening of a door to record an event in memory. However, the sensing of the door opening in no way causes a lock to change its condition so that when the door of the Lavigne carrier is thereafter closed, it is held closed and locked. The portion of the Lavigne reference cited against claim 3 in the Action (Column 6, lines 47-56) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened. Nothing in Lavigne discloses or suggests that in response to sensing the opening of a drawer, a lock condition is changed so that the door will be locked the next time it is closed as specifically recited in claim 3.

As Lavigne neither discloses nor suggests the features specifically recited in claim 3, it is respectfully submitted that this claim is further allowable.



#### **Claim 24**

Claim 24 is an independent apparatus claim which was rejected in the Action on the same basis as claim 1. This rejection is respectfully traversed.

Claim 24 recites a system for providing medical items. Like claim 1, claim 24 recites a computer in operative connection with a data store. The data store includes user data representative of a plurality of users. The data store also includes item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored. Claim 24 further recites a user interface in operative connection with the computer, which user interface includes an input device. Claim 24 further recites a housing structure including a door. The housing structure includes an interior area with a storage location for at least one medical item. Access to the interior area is controlled by opening and closing the door. Claim 24 further recites a lock module on the housing structure which is in operative connection with the computer. The lock module is operative in response to at least one signal from the computer to change from a locked to an unlocked condition. Claim 24 further recites that in the locked condition of the lock module, the door on the housing is prevented from being opened, and in the unlocked condition of the lock module the door is enabled to be opened.

Claim 24 further recites that responsive to a user inputting identification data corresponding to data representative of an authorized user in the data store, the computer is enables the input of item indicia corresponding to a medical item through the input device. Claim 24 further recites that a computer operates responsive to the input of the item indicia to output the signal which changes the lock module to the unlocked condition, thus enabling a user to open the door of the housing and access the medical item.

As previously discussed in connection with claim 1, nothing in Lavigne provides for comparing information input by a user to information concerning a plurality of authorized users. Nothing in Lavigne discloses or suggests enabling a user to input indicia corresponding to a medical item, responsive to user identification data input by a user corresponding to one of a plurality of authorized users. Nothing in Lavigne discloses or suggests a computer operating responsive to the input of item indicia to change a condition of a lock such that a door can be opened to access the medical item corresponding to the input indicia.

In Lavigne the door on the carrier is always unlocked except when it is locked by the controller due to an out of temperature range event (Column 11, lines 37-43).

It is therefore respectfully submitted that claim 24 patentably distinguishes over Lavigne for these numerous reasons. It is therefore respectfully submitted that claim 24 as well as all the claims that depend therefrom (including claims that are currently withdrawn from consideration) should be allowed. It is further respectfully asserted that claim 24 should be allowed because Lavigne does not constitute prior art against the invention recited in claim 24.

### **Claim 25**

Claim 25 depends from claim 24 and further recites a door sensor in operative connection with the door and the computer. Claim 25 further recites a latching device which is operative to selectively maintain the lock module in the locked and unlocked conditions. The latching device is operative to hold the lock module in the unlocked condition responsive to the signal changing the lock module to the unlocked condition. Claim 25 further recites that thereafter the computer is operative to cause the output of a further signal which changes the lock module to a locked

condition. Claim 25 further recites that the latching device holds the lock module thereafter in the locked condition. Claim 25 specifies that the further signal changing the lock module to the locked condition is output responsive to the earlier of two events. The events are: (i) the door sensor sensing that the door has been opened, or (ii) the passage of a time delay period after the output of the signal unlocking the lock module, during which delay period the door sensor has not sensed the door being opened. Nothing in Lavigne discloses or suggests these features.

The Action asserts that Lavigne discloses a door sensor and a latching device for selectively maintaining a lock in the unlocked and locked conditions. As previously mentioned however, the portions of the Action cited (Column 6, lines 47-56; Column 7, lines 10-35) merely indicate that Lavigne includes sensors for sensing when doors are open such that the information can be recorded, and that Lavigne also includes a solenoid which can be used to hold the door (21) in a locked condition in those circumstances when an out of range temperature condition has occurred (Column 11, lines 37-43).

Nothing in Lavigne discloses or suggests the features specifically recited in claim 25. As recited, the computer is operative after sending the signal causing the lock module to unlock the door to maintain the lock module in the unlocked condition, until the earlier of the door being sensed as open or the passage of a time delay period, at which point a further signal is output changing the lock module to the locked condition. As these features are neither disclosed nor suggested in the cited art, it is respectfully submitted that claim 25 as well as claim 26 which depends therefrom, are further allowable on this basis.

### **The Colson Reference**

In the Action claims 1 and 24 were rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Colson. This rejection is also respectfully traversed.

Colson discloses a cabinet system for holding items therein. Colson has a cabinet (1) with doors which form cavities. One such subcavity (19) includes a computer (21). The computer is described as including a keyboard (23) and optionally a display means, a mouse device and an output device such as a printer.

One of the cavities in the cabinet includes a refrigerator (101) for holding medicines which require lower storage temperatures. The various compartments, including the compartment holding the refrigerator are covered by doors (25). The doors can be opened to access the cavities. Each of the doors has associated therewith a locking/unlocking means (37). The locking means includes a solenoid to control the unlocking thereof.

When a user wishes to access items in a cavity behind one of the doors, the user inputs to the keyboard (23) of the computer information concerning the particular patient and information as to the person entering the data. The computer then causes electrical impulses to be issued that travel to a particular electric solenoid to unlock a particular door and permit access to the interior area of the cabinet behind the unlocked door (Column 5, lines 17-27).

It should be noted particularly that Colson does not state that any comparison is made of the information that is input as to the person entering the data, to any data concerning authorized users or to any data stored in a data store. The operation of Colson merely specifies that information is input, the door is unlocked and records are updated.

### **Claim 1**

Claim 1 patentably distinguishes over Colson for the same reasons that this claim patentably distinguishes over Lavigne. There is no disclosure or suggestion whatsoever in Colson that Colson has a computer in connection with a data store with authorized user data, data representative of medical items or data corresponding to storage locations where medical items are stored. Further nothing in Colson discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users. As Colson expressly states, a user of the Colson device inputs information concerning a patient and information on the person entering the data and the door opens. There is no teaching, suggestion or motivation in Colson that a comparison is made of input user identification data to data concerning a plurality of authorized users.

Claim 1 also specifically recites that the computer enables a user to input indicia corresponding to a medical item through an input device. As Colson expressly indicates, no item indicia corresponding to a medical item is input into the Colson computer. Colson receives information concerning a patient and the person entering the data, which then causes a door of Colson to open. Nothing in Colson discloses or suggests this feature which is specifically recited in claim 1.

Claim 1 further recites that the computer is operative responsive to input of the item indicia corresponding to a medical item, to output a signal changing a lock from a locked to an unlocked condition, enabling opening a door of the refrigerator. Again Colson does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock.

As claim 1 recites these numerous features which are neither disclosed nor suggested in Colson, it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including such claims as are currently withdrawn from consideration) are patentably distinguishable over the cited art.

#### **Claim 24**

As previously discussed, Colson is not prior art against claim 24. For this reason it is respectfully submitted that claim 24 as well as all the claims that depend therefrom cannot be rejected on the basis of Colson.

Even if Colson were prior art against claim 24, claim 24 would not be anticipated thereby for the reasons previously discussed in connection with claim 1. Specifically claim 24 recites a computer including a data store. The data store includes data representative of a plurality of authorized users, a plurality of medical items and a plurality of storage locations where medical items are stored. Colson does not disclose or suggest this.

Claim 24 further specifically recites that when a user inputs identifying data through an input device, which data corresponds to an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item. Colson likewise does not disclose or suggest this.

Claim 24 further recites that responsive to the input of item indicia the computer is operative to output a signal changing the lock module controlling the door of the housing to an unlocked condition. Colson does not disclose or suggest changing the condition of a lock responsive to the input of indicia corresponding to a medical item, which input itself is enabled

responsive to input by a user of data corresponding to one of a plurality of authorized users that is stored in a data store.

Colson in contrast, only provides that a user inputs coded information concerning a particular patient and the person entering the data, and a solenoid unlocks a lock (Column 5, lines 17-27). Nothing in Colson discloses or suggests that any indicia is compared to a database of authorized users. Colson does not disclose or suggest enabling the input of indicia corresponding to a medical item. Colson does not disclose or suggest the input of the medical item indicia causing a computer to operate to unlock a lock.

As claim 24 recites these numerous features and relationships that are neither disclosed nor suggested in the cited art, it is respectfully submitted that claim 24 as well as all the claims that depend therefrom are further allowable on this basis.

Applicants also wish to point out that the cited portions of Colson in the Office Action do not stand for the propositions asserted therein. Indeed Colson expressly states that it operates in the manner discussed herein, and not in the manner claimed in Applicants' claims 1 and 24. In addition it should be pointed out that there can be no assertion by the Patent Office that Colson somehow inherently includes the features recited in Applicants' claims. The Federal Circuit has put an end to such speculative rejections. In re Robertson, 169 F.3d 743, 49 USPQ 2d 1949 (Fed. Cir. 1999). As the Federal Circuit has stated, anticipation by inherency may not be established based on mere probabilities or possibilities, or that an invention in a reference could operate in the manner recited in a claim. Rather the Patent Office specifically bears the burden of showing that all of the features and relationships recited in a claim are specifically disclosed in a single prior art reference before a claim may be rejected on the basis of anticipation.

## **The Pending Claims Are Not Obvious in View of the Cited Art**

In the Action claims 1-3 and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) over Lavigne. This rejection is respectfully traversed. Applicants first wish to point out that Lavigne is not prior art against Applicants. Applicants reduced to practice the inventions claimed in at least claims 24 and 45 prior to the filing date of Lavigne. However Applicants will establish that Lavigne even if it were prior art against Applicants' claims, does not render such claims obvious.

## **The Legal Standard**

Before a claim may be rejected on the basis of obviousness the Patent Office bears the burden of establishing that all of the recited features in the claim are known in the prior art. This is known as prima facie obviousness. To establish prima facie obviousness it must be shown that all of the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Further even if all of the features recited in a claim are known in the prior art, there must be further shown by the Patent Office a teaching, suggestion or motivation to produce the claimed combination. Panduit Corp. v. Denison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ 2d 1593 (Fed. Cir. 1987); In re Newell, 891 F.2d 899, 901-902, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1989). Any teaching, suggestion or motivation to combine features in prior art references must be clearly and particularly shown in the prior art to support rejection on the basis of obviousness. It is not sufficient to sustain an obviousness rejection to offer a range of sources and make conclusory statements. In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).



### **Applicants Incorporate the Previous Arguments**

In the Action claims 1-3 and 24-26 were rejected as obvious over Lavigne. However as previously discussed in connection with claims 1, 3 and 24-25, Applicants' claims recite numerous features which are not disclosed or suggested in Lavigne. As a result such rejection against any of these claims is clearly improper under the express provisions of MPEP § 2142.

Claim 2 is the only claim specifically discussed in the § 103 rejection based on Lavigne. As a result Applicants can only respond to this discussion.

### **Claim 2**

Claim 2 depends from claim 1 and further recites that the lock module further comprises a visual indicator. Claim 2 further recites that the visual indicator provides an indication responsive to the signal that the door is enabled to be opened. Lavigne neither discloses nor suggests this.

Contrary to the assertion in the Action, the LEDs of Lavigne are specifically used to indicate temperature conditions (Column 11, lines 25-43). While it is true that in circumstances when a temperature violation has occurred in Lavigne a lock will lock the access door and a controller will also activate a visual indicator, such disclosure is not pertinent to what Applicants have claimed. Specifically the invention recited in claim 2 concerns an arrangement under which a signal is provided by the computer unlocking a door and enabling access to medical items in an interior area. As previously discussed, Lavigne's door is always unlocked except in those limited circumstances where an out of temperature event has caused the possibility of contamination. Thus there is no visual indicator in Lavigne that operates to give an indication of a signal being

provided by a computer which unlocks a door. Indeed the disclosure of Lavigne is totally contrary to the features and relationships recited in the claim.

A reference that teaches away from a recited invention cannot support an assertion of obviousness. In re Fine, 5 USPQ 1598-99 (Fed. Cir. 1988). As Lavigne teaches features and relationships contrary to those recited in claim 2, it is respectfully submitted that the rejection presented in the Action is improper and should be withdrawn.

Applicants also respectfully wish to point out that the Action provides no citation to any teaching, suggestion or motivation to produce Applicants' claimed combination. As the Action is deficient in this regard, it is respectfully submitted that claim 2 is further allowable on this basis.

The rejection also makes a statement concerning taking "official notice" of permanent magnet solenoids and their advantages. Applicants respectfully traverse this assertion both on the basis that it is not applied against any claim, as well as that it is not supported by any reference to prior art. The Patent Office is not permitted to rely merely on assertions of "official notice" as the basis for rejecting claims, and when challenged is required to establish such assertions in the proper manner through citation to prior art. MPEP § 2144.03.

Because Lavigne is not prior art against at least Applicants' claims 24 and 45, it is respectfully submitted that the rejection should be withdrawn. In addition as Lavigne does not disclose or suggest the features specifically recited in claim 2 (or any of Applicants' other claims) and there is no teaching, suggestion or motivation cited in the Action to combine features so as to produce Applicants' claimed combination, it is further respectfully submitted that the rejection is improper and should be withdrawn.

### **The Aten Reference**

In the Action claims 1, 3 and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Lavigne in view of Aten, et al. (“Aten”). This rejection is respectfully traversed.

First, Lavigne is not prior art against at least Applicants’ claims 24 and 45 as previously discussed.

Second, Lavigne does not disclose or suggest numerous elements that are recited in claims 1, 3 and 24-26 as previously discussed. The rejection of Lavigne combined with Aten does not specifically cite to any features in Aten to overcome the deficiencies of the prior rejection, nor is there any teaching, suggestion or motivation in any cited art to produce Applicants’ claimed combinations. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion based on the combination with Aten that discusses any features recited in any of the pending claims might concern claim 26, although this claim is not mentioned. It is asserted that Aten discloses a lock which is actuated by a solenoid. The Action apparently asserts that it would be obvious to have such a lock be a permanent magnet latching solenoid in view of the teachings of Aten. This assertion to the extent it is understood, is respectfully traversed.

Aten is a medication dispenser which includes a rotatable wheel (34). The wheel is turned so that the user may access medical items. It is discussed in the portion of Aten cited in the Action (Column 8, line 66-Column 9, line 19) that a latching mechanism which includes

three magnets can be used in conjunction with the wheel to be sure that the wheel moves through the desired increments to dispense medical items.

It is asserted in the Action that Aten somehow teaches the use of a permanent magnet latching solenoid by virtue of mentioning that permanent magnets may be used as a means for making sure that a rotatable wheel moves to desired positions. Applicants respectfully assert that there is no basis for the contentions in the Action. None of the cited references disclose or suggest a permanent latching solenoid. Nothing in the Action cites to any teaching, suggestion or motivation in any of the cited art to produce the claimed combination. It is therefore respectfully submitted that for all these reasons the rejection of these claims is not proper and should be withdrawn.

#### **Applicants' Claims Are Not Obvious over Colson in View of Lavigne**

In the Action it is asserted that Applicants' pending claims are obvious pursuant to 35 U.S.C. § 103(a) over Colson in view of Lavigne. This rejection is respectfully traversed.

As previously discussed neither of these references is prior art against at least Applicants' claims 24 and 45.

Second, as previously discussed claims 1-3 and 24-25 recite numerous features and relationships that are not found in either of Lavigne or Colson. As previously discussed, before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Colson and Lavigne does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claims are anticipated by the same references.

Thus as the references do not disclose all the elements of the claims (nor any teaching, suggestion or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis.

The rejection on the basis of Colson in view of Lavigne is further respectfully submitted to be improper because it fails to indicate specifically to which claims the asserted features of these references are applied. Rather the rejection leaves the Applicants to speculate as to the assertions being made. As the rejection presented does not comply with the Manual of Patent Examining Procedure in providing Applicants with adequate notice as to which claims the features of the cited art are being applied, it is further respectfully submitted that the rejection is improper and should be withdrawn.

The rejection on the basis of Colson and Lavigne admits that Colson does not disclose a door sensor, that the door is operative to generate a door open signal responsive to the door opening, or a visual indicator located on a lock. The Action asserts however that Lavigne has a door sensor which senses when a door is open. The Action then goes on however to state (without any citation to any teaching, suggestion or motivation in the cited art) that it would be an obvious matter of design choice to move a visual indicator “because the proximate rather than precise mounting location of a visual indicator is sufficient to indicate to the user the identification of the location of the lock corresponds with the compartment(s) and the status of the lock corresponds with the compartment access commands from the computer. [(Column 6, lines 47-56; Column 7, lines 10-35)]. It would have been obvious to use a sensor to detect the opening of the door as a means of saving power and recording removal of the item as taught by

Colson, Jr., et al.” Applicants respectfully submit that this assertion is not sufficient to reject the pending claims.

As previously discussed, Applicants’ pending claim 25 specifically recites that after a signal is given by the computer unlocking the lock, the computer operates in response to sensing either that the door has been opened or the passage of the time delay, to generate a further signal resetting the lock to a locked condition. As a result the door will be locked the next time it is closed. Nothing in the cited art discloses or suggests these features. Nothing in the cited art provides any teaching, suggestion or motivation for producing these features. It is therefore respectfully submitted that claim 25 is further allowable on this basis.

The discussion in the rejection suggests that it may be addressing to some extent features recited in claim 2. This is because claim 2 is the only claim currently under consideration that discusses a visual indicator. Claim 2 as previously discussed, recites a visual indicator in connection with the lock. The visual indicator provides an indication responsive to the signal from the computer that causes the lock to be placed in an unlocked condition. As previously discussed the prior art does not disclose or suggest this feature.

It is respectfully submitted that the rejection on the basis of Lavigne in view of Colson should be withdrawn as it fails to establish that all the features recited in Applicants’ claims are shown in the cited art, and further fails to show that there is any teaching, suggestion or motivation in the cited art for producing the claimed combination.

## **The New Claims Patentably Distinguish Over the Cited Art**

Applicants have submitted new claims 45-47 herein. Each of these claims is patentable for the reasons previously discussed.

### **Claim 45**

Claim 45 is comparable in scope to claim 24. Claim 45 is crafted using wording similar to that in claim 1. However claim 45 like claim 24, specifically recites that the device to which access is controlled is a housing, rather than specifically indicating that it is a refrigerator as recited in claim 1.

As discussed in the Declaration attached hereto, the subject matter of claim 45 was reduced to practice in this country prior to the filing dates of either Colson or Lavigne. As a result these references are not prior art against claim 45 and claim 45 is allowable on this basis.

Claim 45 also includes all of the features which patentably distinguish claims 1 and 24 over the Colson and Lavigne references. As a result claim 45 is allowable even *if* such references were prior art against Applicants. It is respectfully submitted that claim 45 is further allowable on this basis.

### **Claims 46 and 47**

Claims 46 and 47 are similar to original claims 2 and 3 except that such claims depend from claim 45. It is respectfully submitted that such claims are allowable on the same basis as

claim 45 as well as claims 2 and 3. The arguments in support of allowance of claims 2 and 3 are incorporated herein by reference as if fully set forth again herein.

### **Fees For Additional Claims**

Please charge the fees associated with the presentation of one additional independent claim and three additional total claims (\$132) and any other fee due, to the deposit account of Diebold, Incorporated, Deposit Account No. 04-1077.

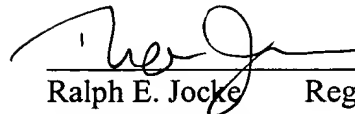
### **Conclusion**

Applicants reduced their invention to practice in this country prior to the filing date of both the Colson and Lavigne references as established by the attached Declaration. Further as pointed out herein, even if such references did constitute valid prior art against Applicants, Applicants' claims recite numerous features and relationships that are neither disclosed nor suggested in the cited references. Applicants further respectfully assert that the withdrawal of the other claims from consideration is improper, and request that all such claims be allowed along with the independent claims from which they depend.

Further examination and reconsideration of the Application in view of the foregoing comments and amendments is respectfully requested. The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.



Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Jockey', written over a horizontal line.

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